

REMARKS

Claims 31 and 32 are currently pending in the present application.

I. The Amended Claims are Not Obvious

In the Office Action mailed November 27, 2007, the Examiner rejected Claims 31 and 32 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Orimo et al. (U.S. Pat. No. 4,338,279 (hereinafter “Orimo et al.”)) in view of Natterer et al. (U.S. Pat. No. 5,027,578 (hereinafter “Natterer et al.”)). Applicants respectfully disagree.

Nonetheless, Applicants herein amend the claims in order to further their business interests and the prosecution of the present application, yet without acquiescing to the Examiner’s arguments, and while reserving the right to prosecute the canceled (or similar) claims in the future. Applicants respectfully submit that the cited references fail to render the amended claims *prima facie* obvious.

The test for *prima facie* obviousness is consistent with legal principles enunciated in *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007). The Federal Circuit summarized the Supreme Court’s holding in *KSR* that “While the *KSR* Court rejected a rigid application of the teaching, suggestion, or motivation (“TSM”) test, the Court acknowledged the importance of identifying ‘a **reason**’ that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does’ in an obviousness determination.” *Takeda Chem. Indus., Ltd. v. Alphapharma Pty., Ltd.*, 06-1329, slip op. (Fed. Cir. June 28, 2007), at 13-14 (quoting *KSR*, 127 S. Ct. at 1731) (emphasis added). Although the TSM test should not be applied in a rigid manner, it can provide helpful insight to an obviousness inquiry. *KSR*, 127 S. Ct. at 1731. The *KSR* Court upheld the secondary considerations of non-obviousness, noting that there is “no necessary inconsistency between the idea underlying the TSM test and the *Graham* analysis.” *Id.* Additionally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See M.P.E.P. 2143.

Applicants respectfully submit that the cited references do not teach, suggest nor enable each element of the claimed invention, thereby precluding a finding of *prima facie* obviousness.

Moreover, absent from the cited references is a teaching or suggestion that would have prompted a reason for one of ordinary skill in the art to combine the elements in the way claimed.

Orimo et al. describe an apparatus utilized for analysis of various sample fluids such as cerebrospinal fluid, blood, and urine. In particular, Orimo et al. describe an apparatus for effecting automatic analysis comprising means for successively feeding reaction vessels each containing a respective test liquid to be analyzed along a given reaction line.

Orimo et al. fail to teach or suggest a method for decreasing the quantity of vapor emissions released into the surrounding atmosphere created during the use of an oligonucleotide synthesizer, wherein the method comprises a) providing an oligonucleotide synthesizer, wherein the oligonucleotide synthesizer comprises a reaction chamber and a lid enclosure, the lid enclosure containing a ventilation system, wherein in an open position, the lid enclosure provides a substantially ventilated workspace via the ventilation system in the lid enclosure, wherein in the open position the ventilated workspace is of sufficient size to permit an operator's hands to enter the reaction chamber; b) connecting the oligonucleotide synthesizer to a ventilation system connected to a source of negative pressure or vacuum; and c) operating the source of negative pressure or vacuum only when the lid enclosure comprising a ventilation system is in the open position; wherein the method is utilized while operating the oligonucleotide synthesizer to synthesize one or more oligonucleotides.

Applicants respectfully submit that Examiner acknowledges that Orimo et al. fail to teach or suggest all limitations of the claims. Specifically, the Examiner states "Orimo does not teach the use of a ventilation cover to evacuate vapors emitted from the device." (Office Action page 3). Applicants respectfully submit that Orimo et al. do not teach or suggest a ventilation cover and method of using the same as claimed in the present invention as one of ordinary skill in the art would immediately appreciate that a reason and/or purpose for a ventilation cover does not exist in the apparatus of Orimo et al. Specifically, Orimo et al. fail to teach or suggest a need for, or a benefit of, decreasing the quantity of vapor emissions released into the surrounding atmosphere created during the use of an oligonucleotide synthesizer while operating an oligonucleotide synthesizer to synthesize one or more oligonucleotides.

Natterer et al. fails to supplement the deficiencies of Orimo et al. Natterer et al. describe a packaging machine for the packaging of materials to be disposed. Natterer et al. fail to teach or suggest a method for decreasing the quantity of vapor emissions released into the surrounding

atmosphere created during the use of an oligonucleotide synthesizer while operating the oligonucleotide synthesizer to synthesize one or more oligonucleotides.

Thus, there exists no teaching or suggestion within either of the cited references, or from anywhere, that would have prompted one of ordinary skill in the art to combine the teachings of either of the references. Moreover, combining the teachings of the cited references fail to teach or suggest all elements of the claimed invention.

Accordingly, Applicants respectfully request that the Examiner withdraw rejection of the claims under 35 U.S.C. § 103(a) and that the Examiner pass the claims to allowance.

CONCLUSION

For the reasons set forth above, it is respectfully submitted that Applicants have addressed all grounds for rejection and request that Applicants' claims be passed to allowance. Should the Examiner believe that a telephone interview would aid in the prosecution of this application, Applicants encourage the Examiner to call the undersigned collect at (608) 218-6900.

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